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10/671,686	09/29/2003	Kazuma Aoki	117025	1077

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EXAMINER

KEEFER, MICHAEL E

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/671,686

Applicant(s)

AOKI ET AL.

Examiner

Michael E. Keefer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/29/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The disclosure is objected to because of the following informalities:

On page 9, in line 2 of [0045], the first word "11" should be deleted and replaced with --111-- to agree with the drawing.

Appropriate correction is required.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Communication Device Preventing Unauthorized Access to its Services via User Intervention and a Method Thereof.

Claim Objections

4. Claims 5, 10, 14, and 19 are objected to because of the following informalities:

Regarding claim 5, it is suggested that the word "absent" in line 3 should be deleted and replaced with the word --not-- to improve the clarity of the claim.

Regarding claim 10, it is suggested that in line 2, the phrase "that requests" should be deleted and replaced with the word --of:-- to improve the clarity of the claim.

Regarding claim 14, it is suggested that the word "absent" in line 3 should be deleted and replaced with the word --not-- to improve the clarity of the claim.

Regarding claim 19, it is suggested that in line 2, the phrase "that requests" should be deleted and replaced with the word --of:-- to improve the clarity of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 1**, which is drawn to a communication device connected to a LAN and a WAN. In order for claimed subject matter to be statutory, it must have a useful, concrete and tangible result. In this case, if the request came from the LAN, or if the user rejects the request, nothing is done, which is not a tangible result output.

Claims 2-10, which are dependent on claim 1, do not remedy the deficiencies of claim 1, and thus are rejected for the same.

Regarding **claim 11**, which is drawn to a method for communicating over a LAN and a WAN. In order for claimed subject matter to be statutory, it must have a useful, concrete and tangible result. In this case, if the request came from the LAN, or if the user rejects the request, nothing is done, which is not a tangible result output.

Claims 12-19, which are dependent on claim 11, do not remedy the deficiencies of claim 1, and thus are rejected for the same.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-4, 11, and 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Amin (US 2001/0051534 A1).

Regarding **claim 1**, Amin discloses:

A communication device (a cellular telephone 100, Fig. 1) connected with a wide area network (WAN) (non-local calling area) and a local area network (LAN) (local calling area), comprising:

a controller that:

determines whether a request to perform predetermined processing came in from the WAN or the LAN; (Note [0042] where it is disclosed that local and non-local calls may be handled differently, showing inherency that the system must be able to determine whether a call is local or non-local)

allows a user of the communication device to determine whether an operation according to the request is accepted or rejected when it is determined that the request came in from the WAN (note Fig. 4 line 210, where a non-local call is handled on a call-by-call basis, and Fig. 5, items

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815-875 where the user is prompted to make a choice whether to accept or decline the call); and

allows the predetermined processing to be performed according to the request when a performance of the operation according to the request is accepted. (Figure 5, Steps 890, 840, 845, show that once the call is accepted the requested voice connection is established.)

Regarding **claim 3 as applied to claim 1**, Amin discloses:

a display unit that displays an inquiry about whether the performance of the operation according the request is accepted or rejected; and ([0075])

an input unit through which the user can input an answer of whether the request is accepted or rejected in response to the inquiry. (A cellular telephone 100 has keys to enter a response, note [0076] and [0078].)

Regarding **claim 4 as applied to claims 1 and 3**, Amin discloses:

wherein the display unit and the input unit are provided at an operating portion. (The display and input units must inherently be placed where a user can interact, or operate with them. I.e. the operating portion of the device.)

Regarding **claim 11**, Amin discloses:

A method of communicating with a wide area network (WAN) and a local area network (LAN) connected to a communication device, comprising:

determining whether a request to perform predetermined processing came in from the WAN or the LAN; (Note [0042] where it is disclosed that local and

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non-local calls may be handled differently, showing inherency that the system must be able to determine whether a call is local or non-local)

allowing a user of the communication device to determine whether an operation according to the request is accepted or rejected when it is determined that the request came in from the WAN (note Fig. 4 line 210, where a non-local call is handled on a call-by-call basis, and Fig. 5, items 815-875 where the user is prompted to make a choice whether to accept or decline the call); and; and

allowing the predetermined processing to be performed according to the request when a performance of the operation according to the request is accepted. (Figure 5, Steps 890, 840, 845, show that once the call is accepted the requested voice connection is established.)

Regarding **claim 13 as applied to claim 11**, Amin discloses:

displaying an inquiry about whether the performance of the operation according the request is accepted or rejected ([0075]); and

inputting a user answer of whether the request is accepted or rejected in response to the inquiry. (A cellular telephone 100 has keys to enter a response, note [0076] and [0078].)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1, 3, 6-7, 9, 11, 13, 15-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susaki et al. (US 6189032 B1), hereafter Susaki and Viets et al. (US 2002/0091532 A1), hereafter Viets.

Regarding **claims 1, 3, 6, and 9**, Susaki discloses:

A communication device (Fig. 1, server 2) connected with a wide area network (WAN) and a local area network (LAN) (communication network 3), comprising:

a controller (see Fig. 3) that:

determines whether a request to perform predetermined processing came in from the WAN or the LAN; (Col 9, Lines 38-48 describes the process of the controller determining whether a request requires the approval of another user)

allows a user of the communication device to determine whether an operation according to the request is accepted or rejected when it is determined that the request came in from the WAN (Col. 10, Lines 1-7 describe how a user is allowed to determine whether a request is allowed or rejected) ; and

allows the predetermined processing to be performed according to the request when a performance of the operation according to the request is accepted. (Col 10, lines 7-9 and 14-18 state that the request is granted and made to process if the request is granted by the other user)

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a display unit that displays an inquiry about whether the performance of the operation according the request is accepted or rejected (See display unit 23 in Fig. 3); and

an input unit through which the user can input an answer of whether the request is accepted or rejected in response to the inquiry. (See input unit 24 in Fig. 3)

wherein the display unit and the input unit are provided at an operating portion. (It is inherent that the display and input units must be in an operating portion, or else they would not function as disclosed by Susaki.)

the controller demands a user of a LAN terminal to determine whether the performance of the operation according to the request is accepted or rejected when it is determined that the request came in from the WAN. (Col. 10, Lines 1-7 describe how a user is allowed to determine whether a request is allowed or rejected)

wherein the controller demands the user of the communication device to determine whether the performance of the operation according to the request is accepted or rejected only when the received request involves predetermined online real-time processing, which is a specified request from the WAN. (Col. 9 lines 42-48 disclose that not only is a user's authority taken into account when determining if a demand for approval is made to a user, but also the type of the request.)

wherein the controller:

exclusively sets a first operation mode in which the determination of whether the performance of the operation is accepted or rejected is demanded; and

sets a second operation mode in which the controller allows the predetermined processing to be performed according to the request that comes in from the WAN when the performance of the operation is accepted aside from the first operation mode. (Note in Fig. 5 it is disclosed that the operation mode can be changed by changing the access limits for a particular service or services to either require another user to approve the request, or to automatically allow the request. See Col. 7, lines 65-67 and Col. 8 lines 1-9)

the controller informs a WAN terminal, that made the request, of a result of the determination by the user of the communication device as to the performance of the operation. (Fig. 11, items 3014 and/or 3018 both inform the requestor of the disposition of the request.)

Therefore, Susaki discloses all the limitations of claims 1, 3, 4, 6-7, and 9 except for the selection criteria specifically being whether a user is located on a LAN or a WAN.

The general concept that users from an external network should have limited access to internal network resources is well known in the art as taught by Viets ("A system and method of limiting access from an external network to documents stored on an internal network." Abstract, lines 1-2.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki with the teaching that users from an external network should have limited access to internal network resources as taught by Viets in order to protect internal resources from abuse (Viets states that unfettered internal network access leads to abuse in [0008] and states that controlled access to network resources is a solution in [0010]).

Regarding **claims 11, 13, and 15-18**, Susaki discloses:

A method of communicating with a wide area network (WAN) and a local area network (LAN) connected to a communication device, comprising:

determining whether a request to perform predetermined processing came in from the WAN or the LAN; (Col 9, Lines 38-48 describes determining whether a request requires the approval of another user)

allowing a user of the communication device to determine whether an operation according to the request is accepted or rejected when it is determined that the request came in from the WAN (Col. 10, Lines 1-7 and 14-18 describe how a user is allowed to determine whether a request is allowed or rejected); and

allowing the predetermined processing to be performed according to the request when a performance of the operation according to the request is accepted. (Col 10, lines 7-9 state that the request is granted and made to process if the request is granted by the other user)

displaying an inquiry about whether the performance of the operation according the request is accepted or rejected; (Fig. 15 shows the display of an inquiry) and

inputting a user answer of whether the request is accepted or rejected in response to the inquiry. (Because in Col 10, lines 7-9 state that the client terminal sends back approval information, it must have been input at some time, via a button on the dialog in Fig. 15. Also see Col. 11, lines 56-62.)

wherein a user of a LAN terminal must determine whether the performance of the operation according to the request is accepted or rejected when it is determined that the request came in from the WAN. (Col. 10, Lines 1-7 describe how a user is allowed to determine whether a request is allowed or rejected)

wherein the user of the communication device must determine whether the performance of the operation according to the request is accepted or rejected only when the received request involves predetermined online real-time processing, which is a specified request from the WAN. (Col. 9 lines 42-48 disclose that not only is a user's authority taken into account when determining if a demand for approval is made to a user, but also the type of the request.)

setting, exclusively, a first operation mode in which the determination of whether the performance of the operation is accepted or rejected is demanded; and

setting a second operation mode in which the controller allows the predetermined processing to be performed according to the request that comes in from the WAN when the performance of the operation is accepted aside from the first operation mode. (Note in Fig. 5 it is disclosed that changing the access limits for a particular service or services to either require another user to approve the request, or to automatically allow the request can change the operation mode. See Col. 7, lines 65-67 and Col. 8 lines 1-9)

informing a WAN terminal, that made the request, of a result of the determination by the user of the communication device as to the performance of the operation. (Fig. 11, items 3014 and/or 3018 both inform the requestor of the disposition of the request.)

Therefore, Susaki discloses all the limitations of claims 11, 13, 15, and 18 except for the selection criteria specifically being whether a user is located on a LAN or a WAN.

The general concept that users from an external network should have limited access to internal network resources is well known in the art as taught by Viets ("A system and method of limiting access from an external network to documents stored on an internal network." Abstract, lines 1-2.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki with the teaching that users from an external network should have limited access to internal network resources as taught by Viets in order to protect internal resources from abuse (Viets states that

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unfettered internal network access leads to abuse in [0008] and states that controlled access to network resources is a solution in [0010]).

Regarding **claim 20**, Susaki discloses:

A communication device connected with a wide area network (WAN) and a local area network (LAN), comprising:

a controller that:

automatically performs predetermined processing according to a request when a performance of an operation is requested by a LAN (Col. 9 lines 57-67 disclose that if a client is in a group that does not require approval the request is automatically granted);

allows a user of the communication device to determine whether an operation according to the request is accepted or rejected when it is determined that the request came in from the WAN (Col. 10, Lines 1-7 and 14-18 describe how a user is allowed to determine whether a request is allowed or rejected); and

performs predetermined processing according to a request from the WAN when a performance of the operation according to the request is accepted. (Col 10, lines 7-9 states that the request is granted and made to process if the other user grants the request.)

Therefore, Susaki discloses all the limitations of claim 20 except that the defining characteristic of the two groups is their presence on a LAN or a WAN.

The general concept of allowing local users more privileges than external users is well known in the art as taught by Viets (which teaches that local users of an intranet have more access to network resources than external (WAN) users, as only requests from external users are filtered by the control server, not requests from internal servers).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki with the teaching of allowing local users more privileges than external users is well known in the art as taught by Viets in order to avoid duplicating network resources separately for external users. (Viets, [0009])

10. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susaki and Viets as applied to claims 1 and 11 above, and further in view of Joubert et al. (US 6101616), hereafter Joubert.

Susaki and Viets teach all the limitations of **claims 2 and 12** except for an IP address table used to differentiate between terminals.

The general concept of using IP addresses to identify terminals on a network is well-known in the art as taught by Joubert (Col. 2, lines 22-25 teach that a table is used to correspond IP addresses to terminal MAC addresses for unique identification, further, lines 30-36 teach that terminals should use their IP address in LAN communications and that unique terminals can be identified by using a table to look up a correspondence between an IP address and a unique MAC address).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki and Viets with the general concept of using IP addresses to identify terminals on a network as taught by Joubert in order to be more robust.

11. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susaki and Viets as applied to claims 1 and 11 above, and further in view of Allen et al. (US 2003/0041333 A1), hereafter Allen.

Susaki and Viets teach all of the limitations of **claims 5 and 14** except for the requester being notified if the authorization request times out.

The general concept of notifying a requester if a request times out is well-known in the art as taught by Allen ("the user rejecting the request or not accepting the request within an established time interval a pre-recorded video greeting is sent" Abstract lines 5-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki and Viets with the teaching of notifying a requester if a request times out as taught by Allen in order to increase user efficiency.

12. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susaki and Viets as applied to claims 1 and 11 above, and further in view of Boehmke et al. (US 2002/0126822 A1) hereafter Boehmke.

Susaki discloses that a server provides "services" but does not specifically define them.

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Susaki and Viets teach all the limitations of **claims 10 and 19** except for that the request received from the LAN or the WAN is at least one of: performance of a printing operation, transmission of facsimile data, reading of data from detachably attachable memory, setting change of device, and reading of received facsimile data, and processing is performed in accordance with the received request. Susaki merely teaches that the server provides "services".

The general concept of a server being able to provide printing and facsimile related services is well-known in the art as taught by Boehmke ([0062] teaches that a server may transmit data to one or more peripheral devices such as printers and facsimiles, among others).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Susaki and Viets with the teaching of a server being able to provide printing and facsimile related services as taught by Boehmke in order to make the server more versatile.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571) 270-1591. The examiner can normally be reached on Monday-Thursday 8am-5pm, second Fridays 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on (571) 270-1808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 1/19/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Frantz Jules', with a large, sweeping horizontal stroke at the end.